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10/798,311	03/12/2004	Wilfried Blum	P1112US00	5775
76753 7590 01/22/2010 BENOIT & COTE, s.e.n.c. 1001, DE MAISONNEUVE BOULEVARD WEST SUITE 210 MONTREAL, QC H3A 3C8 CANADA			EXAMINER FISHER, PAUL R	
			ART UNIT 3689	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/798,311	Applicant(s) BLUM ET AL.	
	Examiner PAUL R. FISHER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-20,28,29,31-34 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-20,28,29,31-34 and 36-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Request for Continued Examination submitted on December 14, 2009 has been acknowledged. Claims 3, 8, 21-27, 30 and 35 have been canceled. Claims 1, 2, 4-7, 9-20, 28-29, 31-34, and 36-42 are currently pending and have been considered below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 14, 2009 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2, 4-7, 9-20, 28-29, 31-34, 36-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly recited

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limitation of "said assessment comprising a grade for the vehicular part" found in claims 1, 28 and 41 has no support in the applicant's specification. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. Since they are equivalent there is no support for the assessment to comprise a grade, and that the grade and not the assessment is used to determine the disposition of the part.

5. Claims 1-2, 4-7, 9-20, 28-29, 31-34, 36-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. Since they are equivalent there is no support for the assessment to comprise a grade, and that the grade and not the assessment is used to determine the disposition of the part. One of ordinary skill in the art would not be able to perform the claimed invention based on the specification since there is no clear guidance as to how the assessment can comprise a grade when the grade is equivalent to the assessment.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-2, 4-7, 9-20, 28-29, 31-34, 36-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In claim 1, the recited term "said assessment comprising a grade for the vehicular part", renders the claim indefinite. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. It is therefore confusing what is meant by grade and how the assessment can comprise a grade when the grade and the assessment are considered to be equivalent.

9. Claims 2, 4-7, 9-20, and 38-40 depend from claim 1 and are therefore rejected upon the same rationale.

10. In claim 28, the recited term "include said grade of said assessment", renders the claim indefinite. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. It is therefore confusing what is meant by grade and how the assessment can comprise a grade when the grade and the assessment are considered to be equivalent.

11. Claims 29, 31-34, 36-37 and 42 depend from claim 28 and are therefore rejected upon the same rationale.

12. In claim 41, the recited term "the assessment comprising a grade for the vehicular part", renders the claim indefinite. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with

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the assessment or grading..." the grade and the assessment are equivalent. It is therefore confusing what is meant by grade and how the assessment can comprise a grade when the grade and the assessment are considered to be equivalent.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claims 1-2, 4-7, 9-20, and 38-41 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant

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extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because while the claims recite a central server outputting information or sending information the steps of sending or outputting are considered insignificant steps or insignificant extra-solution activity which will not transform an unpatentable principle into a patentable process. That is to say the significant step of determining a disposition of said vehicular part is not being performed by a machine particular or otherwise and therefore the method steps fail to be significantly tied to any particular machine.

Further, applicant's method steps fail the second prong of the test because there is no underlying subject matter has been transformed. A document is not transformed into another state or thing by merely updating the information stored in the document. That is to say the document is, still a document the addition of new data is not a transformation.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. **Claims 28, 29, 31, 32, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Joao (US2002/0016655A1).**

As per claim 28, Joao discloses a data center used in a remote evaluation of a vehicular part (Figure 1; discloses a central processing computer or server which takes in data from various other locations for the evaluation of vehicle parts), said data center comprising:

a computer server adapted to communicate with a vehicular dealer and an assessment center (Figure 1; discloses that the central processing computer or server communicates with other computers across the network, this would include the vehicle dealer computer character 40 and the vehicle service provider computer or the assessment center. Further the central processing computer could also communicate with any of the computers connected to the network), said computer server comprising:

input means for receiving, from said vehicular dealer, said electronic folder including said description information regarding said condition of said vehicular part in an electronic folder (Page 21, paragraph 283; discloses that the user enters information that is to be sent to the central server via a computer. Page 12, paragraph 173; discloses various input devices to enter information into the system);

output means for sending said description information to said assessment center (Page 15, paragraph 213; discloses output devices the could be used by the system);
and

said input means for receiving, from a terminal of said assessment center, an assessment based on said description information, said assessment comprising a grade

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for the vehicular part, said electronic folder having been modified at said terminal of said assessment center to include said grade of said assessment, prior to disposition being determined for the vehicular part (Page 22, paragraph 293; discloses the user being sent the report or assessment. Page 12, paragraph 173; discloses various input devices to enter information into the system. Page 20, paragraph 275; discloses that the user of the system can be any of the parties which include vehicle service providers any of these parties can enter information or modify the electronic folder. Page 21, paragraph 285; discloses that a user of the system can modify the document to include an assessment or information regarding the vehicles malfunction problems. Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the assessment center enters data regarding the vehicle and its parts at any time during the process and this entry is done from a terminal at the assessment center and that the system includes an input means for receiving this information).

said output means for sending said electronic folder, once modified to include said grade, to the vehicular dealer, where the grade will be used to determine the disposition of the vehicular part (Page 15, paragraph 213; discloses output devices the could be used by the system).

The information being transfer or sent and received is considered to be non-functional descriptive material since it adds not further limitations to the structure of the system and is therefore given little or no patentable weight.

As per claim 29, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 31, Joao discloses the above-enclosed invention, Joao further discloses comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15, paragraph 206; discloses that the system includes a database that will be used to store all of the information).

As per claim 32, Joao discloses the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third location and said output means further sends said assessment to said third location (Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

As per claim 36, Joao discloses the above-enclosed invention, Joao further comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15, paragraph 206; discloses that the system includes a database that will be used to store all of the information).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claims 1, 2, 4-7, 9-20, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Amir M. Hormozi: "Parts Remanufacturing in the Automotive Industry" (First Quarter 1997) hereafter Hormozi.**

As per claim 1, Joao discloses a method for remotely evaluating a vehicular part (Page 1, paragraph 9; discloses that the invention pertains to vehicle maintenance, and that information is shared. Page 2, paragraph 15; discloses that there is a central point in which the different parties communicate through and that one of the parties are vehicle parts providers) comprising:

obtaining, from a vehicular dealer, description information regarding said vehicular part in an electronic folder (Page 21, paragraph 281; discloses that the information is gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer);

sending, from a central server, said electronic folder including said description information to an assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21,

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paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center);

modifying, at a terminal at said assessment center, the electronic folder to include an assessment, said assessment being based on said description information and comprising a grade for the vehicular part, the electronic folder once modified corresponding to an updated electronic folder (as best understood by the Examiner a grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading...") (Page 20, paragraph 275; discloses that the user of the system can be any of the parties which include vehicle service providers any of these parties can enter information or modify the electronic folder. Page 21, paragraph 285; discloses that a user of the system can modify the document to include an assessment or information regarding the vehicles malfunction problems. Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the assessment center enters data regarding the vehicle and its parts at any time during the process and this entry is done from a terminal at the assessment center);

receiving from said assessment center, the updated electronic folder (Page 22, paragraph 297; discloses that the service provider or repair facility which is considered

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the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well);

sending said updated electronic folder from said central server to said vehicle dealer (Page 3, paragraph 39; discloses that the apparatus can send or output repair reports to the vehicle dealer; Page 10, paragraph 157; discloses that the vehicle dealer computer is in communication with the central processing computer or central server);

displaying said assessment of said updated electronic folder, with said grade, at said vehicular dealer (Page 15, paragraph 213; discloses output devices the could be used by the system, which includes a display for displaying the information. Page 15, paragraph 214; discloses that the information stored in the system can be made available to any of the users of the system which include the vehicular dealer, from this it is obvious that the information is displayed);

wherein said modifying the electronic folder to include said modifying the electronic folder to include the assessment is performed prior to the determining the disposition at the vehicular dealer (Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the assessment center enters data regarding the vehicle and its parts at any time during the process and this entry is done from a terminal at the assessment center, which includes prior to the determining of the disposition).

Joao fails to fully disclose determining whether at said vehicular dealer determining said vehicular part may be recycled or disposed based on said assessment.

Hormozi, which talks about parts remanufacturing in the automotive industry, teaches determining whether said vehicular part may be recycled based on said assessment (Page 26, paragraphs 1 and 2; teach that there are different strategies in saving customers money and address the concerns of different constituencies, some of them include recycling and remanufacturing, as discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade. Page 1, paragraph 4; teaches that the process of remanufactured products includes inspection to determine if the product is capable of being remanufactured parts are too badly worn are replaced. This inspection is an assessment of the part itself to determine if it needs to be replaced or is capable of being salvaged).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of recycling taught by Hormozi, to accomplish the required services for the customer for less. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled.

As per claim 2, the combination Joao and Hormozi teaches the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page 13, paragraph 185).

As per claim 4, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 5, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses wherein said data and reports are compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 6, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses that information will be sent to the warranty providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein said disposition of said vehicular part comprises at least one of discarding the vehicular part and a warranty settlement for said vehicular part based on said assessment.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the vehicle provided by Joao, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 7, the combination Joao and Hormozi teaches the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 9, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page 22,

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paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 10, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses wherein said data and reports are in such a format as to be compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 11, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses that the system is used to facilitate the process of repairing parts or performing services associated with those parts (Page 22, paragraph 290; discloses the central server takes in information that will help in the repair process for parts and services). Joao also discloses that many facilities can access the system (Page 22, paragraph 299; discloses that multiple parties can access the system in regard to repair and servicing of parts, these parties include intermediary or third party sites).

Joao fails to explicitly disclose sending said vehicular part to a third party for at least one of repair and recycling.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches sending vehicular parts to a third party and that services provided by the third party include repair and recycling (Page 26, paragraphs 2 and 6; teach that there are

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five services that can be performed two of which are repair and recycling, and that 90% of sales come from independent channels such as third parties. Page 26, paragraph 8; teaches that companies like Ford motor company have often relied on third party sites to repair and remanufacture items since they did not have the resources, from this it would be obvious that in the case of repair and recycling of parts third parties would be used if the facilities such as the dealer does not have the resources on site to complete the task. Also it would have been obvious that since these third party sites are not located on site they would have to have the parts sent to them).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of sending third parties parts for repair or recycling taught by Hormozi, to accomplish the required services for the customer. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled. Since the system is dealing with third parties or companies that are not onsite the parts that have to be services would have to be sent to them in order for them to be repaired or recycled.

As per claim 12, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses providing an assessment based on vehicular

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parts (Page 22, paragraph 289; discloses that the different services providers can provide a diagnosis or an assessment regarding the state of disrepair of the part).

Joao fails to explicitly disclose comprising at least one of identifying and ordering missing materials required for a remanufacturing of said vehicular part based on said assessment.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising at least one of identifying and ordering missing materials required for remanufacturing of said vehicular part based on said assessment (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced).

As per claim 13, the combination Joao and Hormozi teaches the above-enclosed invention; Joao fails to fully disclose comprising the automatically ordering said materials required for remanufacturing of said vehicular part.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising the automated ordering of said materials required for remanufacturing of said vehicular part (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced and that these pieces are ordered automatically if it is guaranteed that those parts will be replaced, as stated with a RF rating of 1.00, which states that every time the person in going to remanufacture that part, that piece is going to have to be replaced every time).

As per claim 14, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses that original equipment manufacturers have intermediaries or third parties handle things (Page 2, paragraph 21; discloses that intermediaries can act on behalf of the vehicle manufacturers which are the OEM or original equipment manufacturers. Page 22, paragraph 299; discloses that these intermediaries can access the system at any time. Page 21, paragraph 281; discloses that the first location can be the vehicle manufacturer and/or intermediaries).

Joao fails to explicitly disclose where the representative or intermediary is authorized.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches that representatives of the original equipment manufacturer are authorized (Page 26, paragraph 8; teaches that Ford used outside companies as intermediaries for the exchanged of parts and services and those intermediaries were authorized representatives).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of authorized intermediaries or third parties taught by Hormozi, for the purpose of ensuring the quality of work to their customers. If the third party did not have a high standard of work it would reflect poorly upon the original equipment manufacturer so by authorizing these companies shows the customer that these facilities are up to par with the original equipment manufacturer. Also as stated in the article this deal benefits the OEM because in some cases these

they don't have the infrastructure or the resources to take on such a service so these third parties offer a reliable alternative.

As per claim 15, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses wherein assessment center comprises at least one of an independent assessing center, an original equipment manufacturer, and a warranty processing center (Page 22, paragraph 290; discloses that the assessment can be any one of an independent assessing center or repair shop, equipment manufacturers, warranty providers as well as others).

As per claim 16, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising the step of providing access to a party at a third location to said assessment (Page 22, paragraph 299; discloses that access is granted to multiple parties at any point and those parties include intermediaries or third parties. These parties can access the system to view the assessment and to add information).

As per claim 17, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses wherein said party at said third location accesses said assessment through an Internet web browser (Page 11, paragraph 168; discloses that the invention functions on the Internet and can be accessed using a web site which accessing would have to include the use of a web browser).

As per claim 18, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses wherein said party at said third location comprises an original equipment manufacturer (Page 22, paragraph 299; discloses that

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at any time another party can access the system which includes the vehicle manufacturer or the original equipment manufacturer).

As per claim 19, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising producing data and reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 20, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising providing said data and reports in such a format as to be compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 38, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising selecting an assessment center based on the description information (Page 22, paragraph 296; discloses based on the description information the user can selected an assessment center or any of the service or parts providers).

As per claim 41, Joao discloses a method for remotely evaluating a vehicular part (Page 1, paragraph 9; discloses that the invention pertains to vehicle maintenance, and that information is shared. Page 2, paragraph 15; discloses that there is a central

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point in which the different parties communicate through and that one of the parties are vehicle parts providers), comprising:

inputting, at a vehicular dealer, description information regarding the vehicular part in an electronic folder (Page 21, paragraph 281; discloses that the information is gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer);

sending the electronic folder including the description information to an assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center);

receiving the electronic folder at the assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center. Page 22, paragraph 297; discloses that the service provider or repair facility which is

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considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, from this it is shown that the various users receive the information that was sent);

a terminal at the assessment center modifying the electronic folder to include an assessment based on said description information, the assessment comprising a grade for the vehicular part (as best understood by the Examiner a grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading...") (Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well. Page 20, paragraph 275; discloses that the user of the system can be any of the parties which include vehicle service providers any of these parties can enter information or modify the electronic folder. Page 21, paragraph 285; discloses that a user of the system can modify the document to include an assessment or information regarding the vehicles malfunction problems. Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the assessment center enters data regarding the vehicle and its

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parts at any time during the process and this entry is done from a terminal at the assessment center);

receiving the electronic folder at the vehicular dealer (Page 22, paragraph 293; discloses that the user can receive the diagnostic report. Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center).

displaying said assessment at the vehicular dealer, with said grade (Page 15, paragraph 213; discloses output devices the could be used by the system, which includes a display for displaying the information. Page 15, paragraph 214; discloses that the information stored in the system can be made available to any of the users of the system which include the vehicular dealer, from this it is obvious that the information is displayed);

outputting said grade at the vehicular dealer (Page 3, paragraph 39; discloses that the apparatus can send or output repair reports or assessments to the vehicle dealer; Page 10, paragraph 157; discloses that the vehicle dealer computer is in communication with the central processing computer or central server); and

wherein said modifying the electronic folder is performed prior to the disposition of the vehicular part (Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the

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assessment center enters data regarding the vehicle and its parts at any time during the process and this entry is done from a terminal at the assessment center, which includes prior to the determining of the disposition).

Joao fails to fully disclose determining whether said vehicular part may be recycled or disposed based on said assessment.

Hormozi, which talks about parts remanufacturing in the automotive industry, teaches disposing of the vehicular based on said assessment (Page 26, paragraphs 1 and 2; teach that there are different strategies in saving customers money and address the concerns of different constituencies, some of them include recycling and remanufacturing, as discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade. Page 1, paragraph 4; teaches that the process of remanufactured products includes inspection to determine if the product is capable of being remanufactured parts are too badly worn are replaced. This inspection is an assessment of the part itself to determine if it needs to be replaced or is capable of being salvaged).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of recycling taught by Hormozi, to accomplish the required services for the customer for less. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi

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shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy than having those parts repaired or recycled.

19. Claims 33, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1).

As per claim 33, Joao discloses the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses that information will be sent to the warranty providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein the computer server is adapted to determine the disposition based on said grade, and wherein the output means outputs the disposition, the disposition comprising at least one of a discarding of the vehicle part and a warranty settlement for said vehicular.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty. As discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade.

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Further the grade could be as simple as pass or fail, for example the part is broken or not, and thus the settlement would be based on if the part needs to be replaced.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the vehicle provided by Joao, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 34, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 37, Joao discloses the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third location and said output means further sends said assessment to said third location (Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

20. **Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Hormozi as applied to claim 1 above, further in view of Williams et al. (US 2002/0032573 A1) hereafter Williams.**

As per claim 39, the combination of Joao and Hormozi teaches the above-enclosed invention, but fails to explicitly disclose printing a shipping label based on a destination identified in the determining of a disposition.

Williams, which talks about an apparatus, systems and methods for online, multi-parcel, multi-carrier, multi-service enterprise parcel shipping management, teaches printing a shipping label identifying a destination (Page 27, paragraphs [0447]-[0449]; teaches that a shipping label can be printed by the user of the system identifying a destination as well as package information details).

Therefore, from this teaching of Williams, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by the combination of Joao and Hormozi with the printing of shipping labels that provide destination information as taught by Williams for the purpose of expediting shipping to customers as well as to service providers. By printing the labels from the stored data the user is ensured that the information is up to date and correct, which limits the room for error.

21. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Hormozi as applied to claim 1 above, further in view of Untiedt et al. (7,216,096) hereafter Untiedt.

As per claim 40, the combination of Joao and Hormozi teaches the above-enclosed invention, but fails to explicitly disclose adding an event-driven status indicator to the electronic folder for tracking the progress of a claim concerning the vehicular part.

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Untiedt, which talks about an integrated inventory management system, teaches having an event-driven status indicator for tracking the progress of a vehicular part (Col. 2, lines 23-26, Col. 6, lines 3-36; teach that upon an event happening such as a dealer agreeing or disagreeing to supply a part the information regarding that customer request is updated with the current status in this case if the part was back ordered or not).

Therefore, from this teaching of Untiedt, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by the combination of Joao and Hormozi with the use of status indicators as taught by Untiedt for the purpose of keeping track of client requests and ensuring that the service is fulfilled. By including a status indicator the system is aware if the order has been fulfilled or not and this helps avoid possibly forgetting a service request or trying to fulfill a service request that has already been fulfilled.

22. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Park et al. (US 2001/0039594 A1) hereafter Park.

As per claim 42, Joao discloses the above-enclosed invention, Joao further discloses a central processing computer or central server (Figure 1, character 10; discloses that the system contains a central processing computer or central server), but fails to explicitly disclose comprising validating means (server) for validating contents of said assessment based on a set of pre-defined rules.

Park, which talks about a method for enforcing workflow processes for website development and maintenance, teaches comprising validating means (server) for validating contents of said assessment based on a set of pre-defined rules (Figure 1; teaches that the system includes a server. Page 5, paragraph [0058]; teaches that server includes software that validates user-entered data based on a set of predetermined rules, from this it would have been obvious given that Joao includes a website as shown page 11, paragraph [0168], to include on the server the software to validate user entered data on that website based on predetermined rules as taught by Park to ensure that the information is correct before proceeding).

Therefore, from this teaching of Park, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by Joao with the use of data validation based on rules as taught by Park, for the purpose of ensuring the data is complete and correct before proceeding. Since both Park and Joao show websites that include data entry it would have been obvious that the central server shown in Joao could be programmed to validate the information submitted by the users based on a set of predetermined rules as taught by Park.

Response to Arguments

23. Applicant's arguments filed December 14, 2009 have been fully considered but they are not persuasive.

24. In response to the applicant's argument that, "A "grade" is not equivalent to an "assessment". This is made clear in the following passages taken from the specification," the Examiner respectfully disagrees. The first paragraph recited by the applicant is paragraph [0002]: "Currently there exists no system that allows reducing processing costs by evaluating (i.e., assessing) and grading parts before they leave the dealership". The applicant then states "Note that the term "and" and not "or" is used here to identify the difference between both terms". Paragraph [0002] last sentence from the applicant's originally filed application states:

"Currently, there exists no system that allows reducing processing costs by evaluating and grading parts before they leave the dealership"

It is clear from this the word assessing doesn't even appear in this paragraph, therefore it is not possible to say it clear that a grade is different from an assessment.

The applicant then recites paragraph [0037]: "(...), which displays the electronic folder for each assessed part, including the grading, list of missing parts and original images.", this paragraph is the same as the specification however it does not prove that the assessment is different then grading, rather it shows the grading is an assessment, since the rest of the information contained in the folder is has nothing to do with the assessment of the part but rather it includes missing parts and original images. The applicant argues "This identifies the grade, the list of missing parts and original images

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as a subset of the assessment," the Examiner respectfully disagrees. This shows that the "electronic folder" contains this information not the assessment.

As shown previously the applicant's specification specifically on page 9, paragraph [0034], states "As per step 37, an assessor at the assessment center determines the quality of the core using all of the core information data and additional descriptive information supplied through the electronic folder, if the electronic folder contains sufficient information in order to assess the core (at step 38), then as per step 39, the folder is then returned to the dealer along with the assessment or grading and a list of missing parts. If the assessor cannot accurately determine the quality of the core (at step 38), the assessor can request additional information from the car dealership 21 by returning the electronic core folder with comments or questions. The dealer will add the missing information and return the electronic folder to the assessor. The process can loop through steps 33, 35 and 37 until the assessor is satisfied that the supplied information is sufficient to permit an accurate grading of the quality of the core." From this it is shown that the assessor performs their assessment or grading of the parts this section shows that either the assessment or the grading itself is required to determine the assessment of the condition of the parts, this paragraph no other paragraph in the applicant's specification would lead one of ordinary skill to the conclusion that the grade is included as part of the assessment.

The Examiner asserts that the passages provided by the applicant do not clearly show that the assessment and grading are two separate things and therefore the rejections are maintained.

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25. In response to the applicant's argument that, "Claims 1 and 41 are hereby amended to further recite transformed subject matter," the Examiner respectfully disagrees. No transformation has taken place. The data has not changed form it is still data. Therefore the rejections have been maintained.

26. In response to the applicant's argument that, "Joao never discloses an assessment comprising a grade for a vehicular part," the Examiner respectfully disagrees. As shown above a grade and an assessment are equivalent terms as shown by the applicant's own specification and Joao disclose page 22, paragraph 293; the user being sent the report or assessment. The Examiner asserts that the reference reads over the claims as currently written and therefore the rejections have been maintained.

27. In response to the applicant's argument that, "In claim 28, the "generation" of the assessment (which is what the Final Office Action considers is equivalent to the report of Joao) is performed at the terminal of the assessment center not at the computer server which is what is stated to be the equivalent to the "central processing computer 10"," the Examiner respectfully disagrees. Claim 28, does not recite where the "generation" has taken place rather it states it "input means for receiving" as shown in the above rejection the system of Joao does disclose "input means for receiving" and in fact also discloses modifying the assessment at the terminal of the assessment center or service provider. The rejections are therefore maintained.

28. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the "generation" of the assessment is performed at the terminal of the assessment

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center not at the computer server) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

29. In response to the applicant's argument that, "Joao discloses that the vehicle file is updated once the repair (or other procedure) "has been performed"; or in other words, after a repair (maintenance/procedure) is performed on the vehicle by the dealer, service provider, or repair facility. The claim language now clearly claims otherwise," the Examiner respectfully disagrees. As shown in the above rejection Joao does not limit the updating of the file to after the repair (maintenance/procedure) is performed as suggested by the applicant rather it can occur any time during the process. Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers. The rejections are therefore maintained.

30. In response to the applicant's argument that, "Joao does not disclose (1) "said electronic folder having been modified at said terminal of said assessment center to include said grade of said assessment, prior to a disposition being determined for the vehicular part"; and "said output means for sending said electronic folder, once modified to include said grade, to the vehicular dealer, where the grade will be used to determine the disposition of the vehicular part," the Examiner respectfully disagrees. As discussed above in detail Joao does disclose the means for accomplishing these tasks. See above rejection. Further the Examiner notes that claim 28 is a system claim and requires the

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structure for performing these tasks, further what the data being transferred is not positively claimed and does not change or alter the structure of the claims. For these reasons the rejections have been maintained.

31. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

32. In response to the applicant's request for the exact passage of Hormozi as shown above in the rejection Hormozi does in fact include an inspection of the parts and when combined with Joao does disclose the claims as currently recited. Page 1, paragraph 4; teaches that the process of remanufactured products includes inspection to determine if the product is capable of being remanufactured parts are too badly worn are replaced. This inspection is an assessment of the part itself to determine if it needs to be replaced or is capable of being salvaged. The rejections are therefore maintained.

33. All rejections made towards the dependent claims are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and unpatentable over Joao and Hormozi where applicable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [8am/4:30pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PRF

/Dennis Ruhl/
Primary Examiner, Art Unit 3689